



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

✓0

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/620,641	03/22/96	FREIBERGER	P 10359-11300S

DAVID R GRAHAM, ESQ.  
1337 CHEWON AVENUE  
MILPITAS CA 95035

LMC1/0210

EXAMINER

BRIER, J

ART UNIT	PAPER NUMBER
----------	--------------

2775

20

DATE MAILED: 02/10/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/620,641**

Applicant(s)  
**Frieberger et al**

Examiner  
**Jeffery A. Brier**

Group Art Unit  
**2775**



☒ Responsive to communication(s) filed on Jan 22, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-67 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-67 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2775

## **DETAILED ACTION**

### ***Response to CPA***

1. A continued prosecution application (CPA) request transmittal was filed on 1/22/99. No amendments were indicated as being enclosed in the CPA request transmittal. No amendments have been received since the filing of the CPA request transmittal. The currently pending claims and issues are the same claims and issues present at the time of the final rejection. Thus, the final rejection is maintained and reproduced.

### ***Response to Amendment***

2. The amendment to the list of inventors on page 1 has not been entered since the entry of these amendments into the specification would lead to confusion. Applicant is suggested to provide these amendments as a single deletion of those lines in there entirety and the single insertion of the list in its entirety. The remaining amendments to the specification and the new declaration and power of attorney has been entered.

### ***1.131 Affidavits***

3. The declarations filed on 7/9/98 and 8/7/98 under 37 CFR 1.131 has been considered but is ineffective to overcome the Judson, PointCast, and Schena references.

4. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Judson, PointCast, and Schena references. The declarations do not state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and

Art Unit: 2775

completion of invention in this country or in a NAFTA or WTO member country. MPEP §715.07.

The declarations do not contain an allegation that the acts relied upon to establish the date prior to the reference were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104. MPEP §715.07(c). The declarations do not produce such documentary evidence and exhibits in support of the alleged FACTS. 37 CFR 1.131(b) and MPEP § 715.07. The declarations fail to allege FACTS which allege the conception and the reduction to practice of having the retrieved content data displayed in an area which will not distract the user from the user's primary task. Independent claims 1, 19, and 46 claim this.

Without this allegation and the supporting documentary evidence and exhibits, the rejection of these claims cannot be overcome by the declarations. The declarations fail to allege FACTS which allege the conception and the reduction to practice of a computer program with acquisition instructions, user interface installation instructions for providing a user interface which allows the user to request a set of content data, content data scheduling instructions, and display instructions. Independent claim 49 claims this. Without this allegation and the supporting documentary evidence and exhibits, the rejection of these claims cannot be overcome by the declarations.

5. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Judson, PointCast, and Schena references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a

Art Unit: 2775

problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Documentary evidence and exhibits in support of the alleged FACTS was not provided.

6. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Judson, PointCast, and Schena references to either a constructive reduction to practice or an actual reduction to practice. Diligence is lacking because documentary evidence and exhibits in support of the alleged FACTS was not provided.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1-19, 21-31, 33-46, 48-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Judson U.S. Patent No. 5,572,643.

9. Claims 19, 21, 22, 46, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Pirani et al U.S. Patent No. 5,105,184.

Art Unit: 2775

10. Claims 19, 20, 25-28, 32, and 41-47 are rejected under 35 U.S.C. 102(a) as being anticipated by PointCast as described in the 2-13-96 Wall Street Journal article by Joan E. Rigdon.

11. Claims 1-20, 22-47, and 49-67 are rejected under 35 U.S.C. 102(a) as being anticipated by PCT publication number WO 96/30864 to Schena et al.

***Response to Arguments***

12. Applicant's arguments filed 7/9/98 have been fully considered but they are not persuasive.

13. The arguments concerning Pirani have been considered, but, since Pirani displays to the user in way which will not distract the user from a primary interaction, the arguments are not persuasive. Pirani teaches a local content providing system which feeds information to the means for selectively displaying the information at locations which will not distract the user from a primary interaction via a means for acquiring the information from the local content providing system. Clearly Pirani teach claims 19 and 46. The argument for claim 66 is persuasive because the information added to the software in Pirani is integrated to the screens as illustrated in figure 1 of Pirani.

14. The arguments concerning Judson have been considered, but, since Judson displays to the user in way which will not distract the user from a primary interaction, the arguments are not persuasive. At column 6 lines 35-38 Judson describes displaying the additional information as a line along with the downloaded primary information or as described in the preferred embodiment while awaiting receipt of a selected page an informational message is displayed to the user during

Art Unit: 2775

this period when the user is normally inactive. Clearly Judson teaches the claimed invention. Furthermore Judson is prior art because the declarations are ineffective in overcoming the Judson reference.

15. The argument concerning the Point Cast article at page 22 of applicants amendment failed to consider that the other information listed in the list of types of information which Point Cast software retrieves from the Internet in May of 1996 would include moving video clips (claim 43) and audio (claim 44) since these types of information was present on the Internet prior to May 1996. Claim 40 claims allowing the user to establish a link with the information location.

PointCast does this because PointCast allows the user to personalize the types of news retrieved. Note the Reilly patent from PointCast. Applicant also argued that the invention was conceived and reduced to practice before the publication of the PointCast article. This argument is not persuasive because the declarations are ineffective in overcoming the PointCast reference.

16. The only argument given for Schena is that the invention was conceived and reduced to practice before the publication of the Schena publication. This is not persuasive because claim 66 was rejected by Schena and claim 66 was not listed as a claim conceived and reduced to practice in the declarations. This argument is further not persuasive because the declarations are ineffective in overcoming the Schena reference.

17. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS**

Art Unit: 2775

**ACTION IS MADE FINAL** even though it is a first action after the filing under 37

CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on Mondays through Fridays from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Saras, can be reached on (703) 305-9720. The fax number is (703) 308-6606.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

February 8, 1999

  
JEFFERY BRIER  
PRIMARY EXAMINER